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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,494	08/20/2001	Stephen Paul Morgan	ARC920010079US1	5917

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EXAMINER

MARTINEZ, DAVID E

ART UNIT	PAPER NUMBER
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2182

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DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,494

Applicant(s)

MORGAN, STEPHEN PAUL

Examiner

David E Martinez

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6, 15 and 24 are rejected under 35 U.S.C. 101 because the disclosed invention lacks patentable utility.

As per claim 6, "the system of claim 1, wherein the adapter is not a computer network adapter." Claim 1 recites "a network resource communicating with the adapter". Claim 1 specifically discloses the adapter communicates with a network resource, it is understood that it must be a computer network adapter to do so. Applicant claims the adapter not being a computer network adapter. If it is not a computer network adapter then it cannot communicate with a network resource and therefore lacks utility.

As per claim 15, and 24, they are also both also understood to be a computer network adapter to request network requests. If it is not a computer network adapter then it cannot make network requests and therefore lacks utility.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5, 8, 10, 11, 14, 17, 19, 22, 23, and 26, are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,974,547 to Klimenko.

As per claim 1, Klimenko teaches a system, comprising:

a computer [fig 3, element 10] including a central processing unit (CPU) [fig 3, element 320] but not including a local hard disk drive [fig 3, column 8 line 58 to column 9, line 4];

an adapter coupled to the CPU for receiving local disk I/O requests therefrom [fig 3, element 360]; and

at least one network resource [fig 2a, 4a element 50] communicating with the adapter for satisfying the local disk I/O requests [fig 4A, element 10 shown in communication with element 50].

As per claim 4, the system of Claim 1, wherein the adapter translates disk I/O requests into network I/O requests [column 6, lines 39-51].

As per claim 5, the system of Claim 1, wherein the adapter is also a computer network adapter [fig 3, element 360].

As per claim 8, Klimenko teaches the adapter causes a conventional operating system configured for generating local disk I/O requests to be loaded from a network storage to a volatile memory in the computer [column 9, lines 4-11].

As per claim 10, Klimenko teaches a method for facilitating, in a diskless computer, the use of an operating system not modified to not issue local disk I/O requests [column 6, lines 24-28], comprising:

receiving local disk I/O requests from the operating system; and

satisfying the local disk I/O requests by accessing a network communicating with the diskless computer [column 6, lines 39-51].

As per claim 11, the method of claim 10, wherein the satisfying act includes translating the local disk I/O requests to network requests at an adapter, transparently to a CPU in the diskless computer [It is inherent that the local disk I/O requests are translated into network

requests for the diskless client machine to be using data remotely. Column 3, line 59 to column 4, line 7, column 6, lines 39-51].

As per claim 14, it is of the same scope as that of claim 5, therefore rejected under the same rationale.

As per claim 17, it is of the same scope as that of claim 8, therefore rejected under the same rationale.

As per claim 19, Klimenko teaches a diskless computer [fig 3, element 10, column 8 line 58 to column 9, line 4], comprising:

a CPU [fig 3, element 320] running an operating system not modified to not issue local disk I/O requests [column 6, lines 24-28];

a disk-free adapter communicating with the operating system and receiving disk I/O requests therefrom [fig 3, element 360; and

a network connection through which the disk I/O requests can be satisfied despite the lack of a local hard disk drive in the computer [fig 4A, element 10 shown in communication with element 50, column 6, lines 39-51].

As per claim 22, it is of the same scope as that of claim 4, therefore rejected under the same rationale.

As per claim 23, it is of the same scope as that of claim 5, therefore rejected under the same rationale.

As per claim 26, it is of the same scope as that of claim 8, therefore rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 7, 9, 12, 13, 16, 18, 20, 21, 25, and 27, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,974,547 to Klimenko.

As per claims 2, 12 and 20, Klimenko teaches the adapter is plugged into a motherboard holding the CPU [Klimenko discloses the adapter is a NIC card (fig 3, element 360, column 8, line 60). It is well known NIC cards are expansion cards that plug into a motherboard].

As per claims 3, 13 and 21, wherein the adapter is connected by a connecting cable to a motherboard holding the CPU [It is well known NIC cards can be connected to a motherboard using a cable such as when they are USB NIC cards].

As per claims 7, 16 and 25, it is well known in the art for an adapter to include a sequence of bytes identifying the adapter to the CPU as a secondary boot device. [This is a well known routine in the BIOS (basic-input-output system) which is used as the software that a computer uses to get started. The user is known to have the option to select the location to boot-up the machine from. Common selections are a local hard drive, a remote boot (using a network interface card NIC), disk drive, CD-ROM drive and floppy drive]

As per claims 9, 18, and 27, it is well known in the art, adapter cards are housed within the computer that uses it.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,324,644 to Rakavy et al.

US Patent No. 5,404,527 to Irwin et al.

US Patent No. 5,142,680 to Ottman et al.

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US Patent No. 4,958,278 to Meguro.

US Patent No. 5,349,643 to Cox et al.


US Patent Application Publication No. US2002/0087854A1 to Haigh et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E Martinez whose telephone number is (703) 305-4890. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

DEM


Rehana Perveen
Primary Examiner
Art Unit 2182